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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,915	09/18/2003	Rajendra Mehta	STD 1184 PA/41213.541	6466

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/666,915

Applicant(s)

MEHTA ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 50-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/4/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-49, drawn to a security document, classified in class 428, subclass 195.1.
  - II. Claims 50-59, drawn to method of manufacturing a security document, classified in class 427, subclass 150.
2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by depositing a first security coating on an extruded substrate and depositing a second security coating on the first security coating.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with John Reed on August 9, 2005, a provisional election was made with traverse to prosecute the invention of Group I,

Art Unit: 1774

claims 1-49. Affirmation of this election must be made by applicant in replying to this Office action. Claims 50-59, withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently name inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections – 35 USC § 103(a)***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 6-12, 18-22 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579).

Dotson discloses a security document (column 1, line 11) having a substrate coated with a dye layer which is sensitive to solvent and abrasion (column 7, lines 34-40 and column 8, lines 10-14). Dotson further discloses the substrate being printed having an image (column 2, lines 1-13) using flexographic printing comprising 3 to 15 weight percent liquid dye, about 20 to 40 weight percent water and about 0 to 5 weight percent

film former (column 5, lines 15-21). Although Dotson does not explicitly disclose multiple coatings, it would have been obvious to one of ordinary skill in the art obvious to one having ordinary skill in the art at the time the invention was made to duplicate the coating layer, which is sensitive to solvent and abrasion, since it has been held that mere duplication of essential working parts involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

***Claim Rejections – 35 USC § 103(a)***

8. Claims 16-17 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Taylor et al (U.S. 6,062,604).

Dotson is relied upon for claim 1. Dotson does not disclose folding the document. Taylor teaches a security document comprising optically variable ink (column 1, lines 9-21) formed from a substrate having a coating on one or both sides, where the sheet is flexible and can be folded about a center line, which bring both sides of the folded article together (column 2, lines 22-46). Dotson and Taylor are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have folded the security document, as taught in Taylor, in the security document of Dotson so the second portion of the security document can be inspected or verified by viewing both the first and second portions together (column 2, lines 54-64).

***Claim Rejections – 35 USC § 103(a)***

9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Berson (U.S. 5,932,870).

Dotson is relied upon for claim 1. Dotson does not disclose a bar code. Berson teaches a security document in the form of a drivers license having a bar code for abrasion resistance. Dotson and Berson are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have included a bar code, as taught in Berson, in the security document of Dotson to improve the security for the documents (column 2, lines 20-27).

***Claim Rejections – 35 USC § 103(a)***

10. Claim 15 and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Halbrook, Jr. et al. (U.S. 5,883,043).

Dotson is relied upon for claim 1, as above. Dotson does not explicitly disclose optically variable ink such as thermochromic ink. Halbrook, Jr. teaches a security document (column 1, lines 5-10) having optically variable pigments and dyes such as thermochromic (column 3, lines 1-5). Dotson and Halbrook, Jr. are both directed to security documents. It would have been obvious to one of ordinary skill in the art to have included thermochromic ink, as taught in Halbrook, Jr., in the security document of Dotson to improve the security for the document.

***Claim Rejections – 35 USC § 103(a)***

11. Claims 4-5, 24-29, 33-46 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotson et al. (U.S. 5,814,579) in view of Lu (U.S. 5,591,527).

Dotson is relied upon for claim 1, as above. Dotson does not disclose the article is a drivers license. Lu teaches security articles comprising an image or design (column 1, lines 50-55) having a separation layers (column 2, lines 10-25) where the substrate may be made of paper and is a drivers license (column 3, lines 1-5). Lu further teaches the article has a layer to protect the substrate (column 5, lines 17-22) having a laminate comprising two or more layers (column 12, lines 55-60) which are tear resistant. The article can be coated on the back side of the article (column 16, lines 5-11). Dotson and Lu are both directed to security documents. It would have been obvious to one of ordinary skill in the art for the security document to be drivers license, as taught in Lu having the added security features to protect and identify the consumers using the security cards.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lakes et al (U.S. 5,912,205) teaches a security document having a coating which is solvent and abrasion sensitive (column 3, lines 1-31).

**Conclusion**


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Patent Examiner  
AU 1774



RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 9/21/08